

REMARKS

Claims 8 to 14, and 16 to 19 are currently pending and being considered, since claim 15 was previously withdrawn in response to a restriction requirement.

Reconsideration of the application is respectfully requested based on the following remarks.

With respect to paragraph two (2) of the Final Office Action, claims 8, 11, 12, 13 and 14 were rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,160,309 ("Le") in view of U.S. Patent Application Publication No. 2002/0011661 ("Terasaki et al.").

In rejecting a claim for obviousness under 35 U.S.C. § 103(a), the office bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine the reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 8 is to a diode, including: a press-fit base including an axially extending mounting region to mount a semiconductor chip; a head wire provided with a head configured to be affixed to the semiconductor chip; and a stabilization arrangement which include at least a sleeve and an encapsulating material filling cavities; in which the head wire includes a stepped wire connection having a region, which together with the sleeve and the press-fit base forms a housing, the cavities of the housing being filled with encapsulating material. In this respect, Figures 1 and 2 display this region (21), and the Substitute Specification at page 3, lines 9 to 16, describes this feature. In this way, less epoxy may be used, and the fire risk may be reduced when the diode is overloaded, as explained in the Substitute Specification of the present application.

In contrast, the Le reference nowhere discloses, or even suggests, the feature of a stepped wire connection having a region, which together with the sleeve and the press-fit base forms a housing, as admitted at paragraph 5 on page 2 of the Office Action. Further, the protuberance 6c of the secondary Terasaki reference is not shown as, nor is it disclosed as, providing this function of a stepped wire connection having a region, which together with the sleeve and the press-fit base forms a housing. Indeed, all of Figures 1, 2, and 9 through 14 of

the Terasaki reference indicate that the insulating member 7 is not enclosed within a housing, but is instead free to flow outside of the protuberance 6c, side wall 3a, and support electrode body 3.

Accordingly, the proposed combination of the Le and Terasaki references does not disclose, or even suggest, the feature of a stepped wire connection having a region, which together with the sleeve and the press-fit base forms a housing, as provided for in the context of claim 8. It is therefore respectfully submitted that claim 8 is allowable, as are its dependent claims 11 to 14.

Withdrawal of the rejections is therefore respectfully requested.

With respect to paragraph sixteen (16) of the Final Office Action, claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as unpatentable over Le in view of Terasaki, further in view of U.S. Patent No. 6,274,823 ("Khandros et al.").

Claims 9 and 10 depend from independent claim 8, and are therefore allowable for essentially the same reasons as claim 8, as presented, since the third-level Khandros reference does not cure - and is not asserted to cure - the critical deficiencies of the Le and Terasaki references as to claim 8. Thus, the proposed combination of the Le, Terasaki, and Khandros references does not disclose, or even suggest, the feature of a stepped wire connection having a region, which together with the sleeve and the press-fit base forms a housing, as provided for in the context of claim 8, from which claims 9 and 10 depend.

Withdrawal of the rejections is therefore respectfully requested.

With respect to paragraph twenty-nine (29) of the Final Office Action, claims 16 to 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over Le in view of Terasaki, further in view of Khandros et al.

Claim 16 is similar to claim 8 except that it includes the features of claims 9 and 11. As explained above, and as admitted at paragraph 32 on page 5 of the Final Office Action, the proposed combination of the Le and Terasaki references does not disclose, or even suggest, all of the features of claim 16. Further, since the third-level Khandros reference does not cure - and is not asserted to cure - the critical deficiencies of the Le and Terasaki references as to claim 16, the proposed combination of the Le, Terasaki, and Khandros references does not disclose, or even suggest, the feature of a stepped wire connection having a region, which together with the sleeve and the press-fit base forms a housing, as provided for in the context of claim 16. Accordingly, it is respectfully submitted that claim 16 is allowable for at least the same reasons as claim 8 (and claims 9 and 11), as are its dependent

claims - claim 17 (features correspond to claim 10), claim 18 (features correspond to claims 12 and 13), and claim 19 (features correspond to claim 14).

Withdrawal of the rejections is therefore respectfully requested.

In sum, claims 8 to 14, and 16 to 19 are allowable.

CONCLUSION

Applicants respectfully submit that all pending and considered claims 8 to 14, and 16 to 19 of the present application are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,

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